



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,189	06/13/2001	Yoshitaka Terasaki	109768	4046
25944	7590	06/10/2004		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320				
EXAMINER SORRELL, ERON J				
ART UNIT		PAPER NUMBER		
2182				

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

13

Office Action Summary

Application No.

09/879,189

Applicant(s)

TERASAKI ET AL.

Examiner

Eron J Sorrell

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10,12-19,21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,12-19,21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>3/18/04</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,4, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumpf (U.S. Patent No. 6,581,098).

3. Referring to claim 1, Kumpf teaches an image input and output control apparatus comprising:

a first transmitting and receiving section that transmits and receives data to and from an image input and output apparatus that performs image input and output (see lines 9-24 of column 2 and item labeled 20 in figure 2);

a second transmitting and receiving section that transmits and receives at least two of print data, scan data, and fax data to and from an information terminal apparatus that stores data to be handled by the image input and output apparatus in

Art Unit: 2182

performing input or output (see lines 11-14 of column 1, lines 9-24 of column 2, and item labeled 18 in figure 2); and

a control section that causes data received by one of the first transmitting and receiving section and the second transmitting and receiving section to be transmitted from the other (see lines 9-24 of column 2 and item labeled 24 in figure 2).

4. Referring to claim 4, Kumpf teaches an image input and output system comprising:

an image input and output apparatus that performs image input and output (see lines 36-41 of column 2 and figure 3);

an information terminal apparatus that stores data to be handled by the image input and output apparatus in performing image input or output (see lines 36-41 of column 2 and figure 3); and

the image input and output control apparatus of claim 1 that transmits and receives data to and from each of the image input and output apparatus and the information terminal apparatus (see lines 36-41 of column 2 and figure 3).

5. Referring to claim 6, Kumpf teaches the control section causes, in causing the data received by one of the first

Art Unit: 2182

transmitting and receiving section and the second transmitting and receiving section to be transmitted from the other, the data to be converted into a data format suitable for transmission destination apparatus.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumpf in view of Beach et al. (U.S. Patent No. 6,404,772 hereinafter "Beach").

8. Referring to claim 2, Kumpf fails to teach limitation of the second transmitting and receiving section that transmits and receives data wirelessly to and from a mobile information terminal apparatus.

Beach teaches a system comprising a transmitting and receiving section that transmits and receives data wirelessly to

Art Unit: 2182

and from a mobile information terminal apparatus (see paragraph bridging columns 4 and 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Kumpf with the teachings of Beach such that the second transmitting and receiving section transmits and receives data wirelessly to and from a mobile information terminal apparatus. One of ordinary skill in the art would have been motivated to make such modification to increase the flexibility of the system to allow information terminals to be moved around freely as the user desires and to reduce the amount of wires and/or cables needed in the system.

9. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumpf in view of Leiman et al. (U.S. Patent No. 6,469,796 hereinafter "Leiman").

10. Referring to claim 3, Kumpf fails to teach the image input and output control apparatus comprises a user interface providing section that provides a user interface relating to the image input and output apparatus, however Kumpf does disclose the image input and output control apparatus is a peripheral server (see item 10 in figure 1).

Art Unit: 2182

Leiman, in an analogous system, teaches a image input and output control apparatus comprising a user interface providing section that provides a user interface relating to the image input and output apparatus (see lines 23-26 of column 2).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of Kumpf with the above teachings of Leiman. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to provide a user with a listing of currently pending jobs as suggested by Leiman (see lines 27-41 of column 2).

11. Referring to claim 5, Kumpf fails to disclose the image input and output control apparatus further comprising a billing apparatus that charges, in accordance with image input or output processing of the mage input and output apparatus, a user who has performed image input or output using the information terminal apparatus.

Leiman, in an analogous system, teaches a image input and output control apparatus comprising a billing apparatus that charges, in accordance with image input or output processing of the mage input and output apparatus, a user who has performed

Art Unit: 2182

image input or output using the information terminal apparatus (see lines 20-34 of column 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of Kumpf with the above teachings of Leiman. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to keep track of which users are performing which activities using the image input and output apparatus.

12. Claims 7,8,10,12,13,17-19,21,23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine et al. (U.S. Patent No. 6,020,973 hereinafter "Levine") in view of Beach.

13. Referring to claim 7, Levine teaches an image input and output control apparatus that receives printing data from an information terminal apparatus and transmits the printing data to an image input and output apparatus that prints out the printing data comprising:

a Web server that provides the information terminal apparatus with a user interface for setting a printing condition and instruction execution of printing through a Web browser (see paragraph bridging columns 9 and 10);

Art Unit: 2182

a controller that controls transmission of the received printing data including the printing condition set by the information terminal apparatus to the image input and output apparatus (see lines 1-12 of column 11);

a receiver that receives the printing data from the information terminal apparatus (see item labeled 201 in figure 5); and

a transmitter that transmits the printing data to the image input and output apparatus (see item labeled 208 in figure 5).

Levine fails to teach the receiver receives the printing data wirelessly from the information terminal apparatus.

Beach teaches, a system and method, wherein printing data is received wirelessly (see paragraph bridging columns 4 and 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Levine with the teachings of Beach such that the receiver of Levine is a wireless receiver. One of ordinary skill in the art would have been motivated to make such modification to increase the flexibility of the system by allowing information terminals to be moved around freely as the user desires without being tethered by a cable and to reduce the amount of wires and/or cables needed in the system.

Art Unit: 2182

14. Referring to claim 8, Levine teaches the control apparatus further comprises a memory that stores the received printing data (see lines 10-26 of column 13 and item labeled 204 in figure 5).

15. Referring to claim 10, Levine teaches the receiver and transmitter are isolated from each other physically (see items labeled 201 and 208 in figure 5).

16. Referring to claims 12 and 13, Levine teaches the receiver receives the printing data over a network from the information terminal apparatus and that the transmitter transmits the printing data over a network to the image input and output apparatus (see lines 40-54 of column 8).

17. Referring to claim 17, Levine teaches an image input and output control apparatus that receives first-format data from an information terminal apparatus and transmits second-format data to an image input and output apparatus that prints out the second-format data, comprising:

a Web server that provides the information terminal apparatus with a user interface for setting a printing condition

Art Unit: 2182

and instruction execution of printing through a Web browser (see paragraph bridging columns 9 and 10);

a data converter that converts the received first-format data including the printing condition set by the information terminal apparatus into the second-format data which can be handled by the image input and output apparatus (see lines 40-55 of column 7);

a controller that controls transmission of the second-format data to the image input and output apparatus (see lines 1-12 of column 11);

a receiver that receives the printing data from the information terminal apparatus (see item labeled 201 in figure 5); and

a transmitter that transmits the printing data to the image input and output apparatus (see item labeled 208 in figure 5).

Levine fails to teach the receiver receives the printing data wirelessly from the information terminal apparatus.

Beach teaches, a system and method, wherein printing data is received wirelessly (see paragraph bridging columns 4 and 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Levine with the teachings of Beach such that the receiver of Levine is a wireless receiver. One of

Art Unit: 2182

ordinary skill in the art would have been motivated to make such modification to increase the flexibility of the system by allowing information terminals to be moved around freely as the user desires without being tethered by a cable and to reduce the amount of wires and/or cables needed in the system.

18. Referring to claim 18, Levine teaches the image input and output controller further comprises a memory that stores the received first-format data (see lines 41-65 of column 9).

19. Referring to claim 19, Levine teaches the image input and output control apparatus further comprises a memory to store the converted second-format data (see lines 41-65 of column 9; Note the ESS queue stores jobs until they are ready to be processed by the image input and output device).

20. Referring to claim 21, Levine discloses that the receiver and transmitter are isolated from each other physically (see items 201 and 208 in figure 5).

21. Referring to claims 23 and 24, Levine discloses the receiver receives the first-format data over a network from the information terminal apparatus and the transmitter transmits the

Art Unit: 2182

second-format data over a network to the image input and output apparatus (see lines 15-40 of column 5).

22. Claims 16 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Beach as applied to claims 7 and 17 above, and further in view of Leiman.

23. Referring to claims 16 and 27, the combination of Levine and Beach fails to disclose the image input and output control apparatus further comprising a billing controller that calculates an amount of money to be charged based on a printing condition.

Leiman, in an analogous system, teaches an image input and output control apparatus comprising a billing controller that calculates an amount of money to be charged based on a printing condition (see lines 20-34 of column 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Levine and Beach with the above teachings of Leiman. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to keep track of which users are performing which activities using the image input and output

Art Unit: 2182

apparatus and the amount they should be billed for the activities.

24. Claims 14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view Beach as applied to claims 7 and 17 and further in view of Kurachi (U.S. Patent No. 6,181,436).

25. Referring to claims 14 and 25, the combination of Levine and Beach fails to teach the limitation of the controller deleting the stored first-format data according to a user instruction after the printing has completed.

Kurachi teaches, in an analogous system, a controller deleting the stored first-format data according to a user instruction after the printing has completed (see paragraph bridging columns 8 and 9).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Levine and Beach with the above teachings of Kurachi. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such modification in order to make room in the print queues when jobs are no longer needed to make room for new jobs being submitted.

26. Claims 15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view Beach as applied to claims 7 and 17 above and further in view of Mori (U.S. Patent No. 6,089,765).

27. Referring to claims 15 and 26, the combination of Levine and Beach fails to teach the limitation of the controller deleting the stored second-format data after a lapse of a prescribed time after the printing has completed.

Mori teaches, in an analogous system, a controller deleting the stored second-format data after a lapse of a prescribed time after the printing has completed (see lines 52-61 of column 7).

It would have been obvious to one of ordinary skill in the art the time of the applicant's invention to modify the combination of Levine and Beach with the above teachings of Mori. One of ordinary skill in the art would have been motivated to make such modification in order to in order to allow new jobs to be recorded as suggested by Mori (see lines 52-61 of column 7).

Response to Arguments

28. Applicant's arguments filed 3/24/04 have been fully considered but they are not persuasive. The applicant argues:

1) Kumpf does not disclose or suggest an image input and output control apparatus including at least a transmitting and receiving section that transmits and receives at least two of print data, scan data, and fax data to a from an information terminal apparatus (see lines 15-18 of page 7 of applicant remarks filed 3/24/04).

2) Kumpf does not specifically teach or suggest the transmission and reception of print data, scan data, and fax data (see lines 3-6 of page 8 of applicant's remarks filed 3/24/04).

3) Beach does not specifically teach transmitting and receiving print, scan, and fax data and Beach fails to cure the deficiencies of Kumpf in disclosing a second transmitting and receiving section that transmits and receives at least two of print data, scan data, and fax data (see paragraph bridging pages 8 and 9 of applicant's remarks filed 3/24/04).

4) Leiman fails to cure the deficiencies of Kumpf in disclosing a transmitting and receiving section that transmits and receives at least two of print data, scan data, and fax data (see lines 10-13 of page 9 of applicant remarks filed 3/24/04).

As per argument 1, the Examiner disagrees. Kumpf teaches an image input and output control apparatus (see MFP Server 10 in figure 1) including at least a transmitting and receiving section that transmits and receives at least two of print data, scan data, and fax data to a from an information terminal apparatus (see item labeled Network interface 18 in figure 1). At lines 39-42 of column 1, Kumpf discloses, "An additional object of the present invention is to provide an improved network peripheral server which provides access to a plurality of functions of the multifunctional peripheral **in addition to the print and scan functions** (*emphasis added*).". At lines 9-24 of column 2, Kumpf teaches the MFP Server comprises a network interface, which communicates with clients on the network. It is clear from the teachings of Kumpf that the MFP Server disclosed communicates with clients on the network and provides access to the multifunctional peripherals functions including at least printing and scanning.

Art Unit: 2182

As per argument 2, the Examiner disagrees. There is no limitation in claim 1 that requires the transmission and reception of print data, scan data, and fax data. The limitation only requires the transmission and reception of at least two of those three types. Kumpf specifically states the object of the invention is to provide access to a plurality of functions in a multifunctional peripheral **in addition** to the print and scan functions (emphasis added). This teaching from Kumpf clearly suggests transmission and reception of at least print data and scan data.

As per argument 3, the Examiner disagrees. Firstly, as can be seen from the Examiner's response to applicant's arguments 1 and 2, **there is no deficiency in Kumpf** (emphasis added). Secondly, again there is no limitation in claim 1 that requires the transmission and reception of print data, scan data, and fax data. The limitation only requires the transmission and reception of at least two of those three types. The Examiner has relied on Kumpf for these teachings and only relies on Beach to show transmitting and receiving data wirelessly is well known in the art and an obvious improvement on Kumpf. Lastly, Beach does in fact suggest receiving and transmitting at least print

Art Unit: 2182

data and scan data wirelessly (see paragraph bridging columns 4 and 5).

As per argument 4, the Examiner disagrees. Kumpf is not deficient with respect to disclosing a transmitting and receiving section that transmits and receives at least two of print data, scan data, and fax data (see Examiners response to applicant's arguments 1 and 2).

Conclusion

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J Sorrell whose telephone number is 703 305-7800. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on 703 308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EJS
June 3, 2004



JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2103